

No. 6011.

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IN THE  
United States  
Circuit Court of Appeals,  
FOR THE NINTH CIRCUIT.

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Waterloo Register Company, a corporation,

*Appellant,*

*vs.*

Charles Atherton,

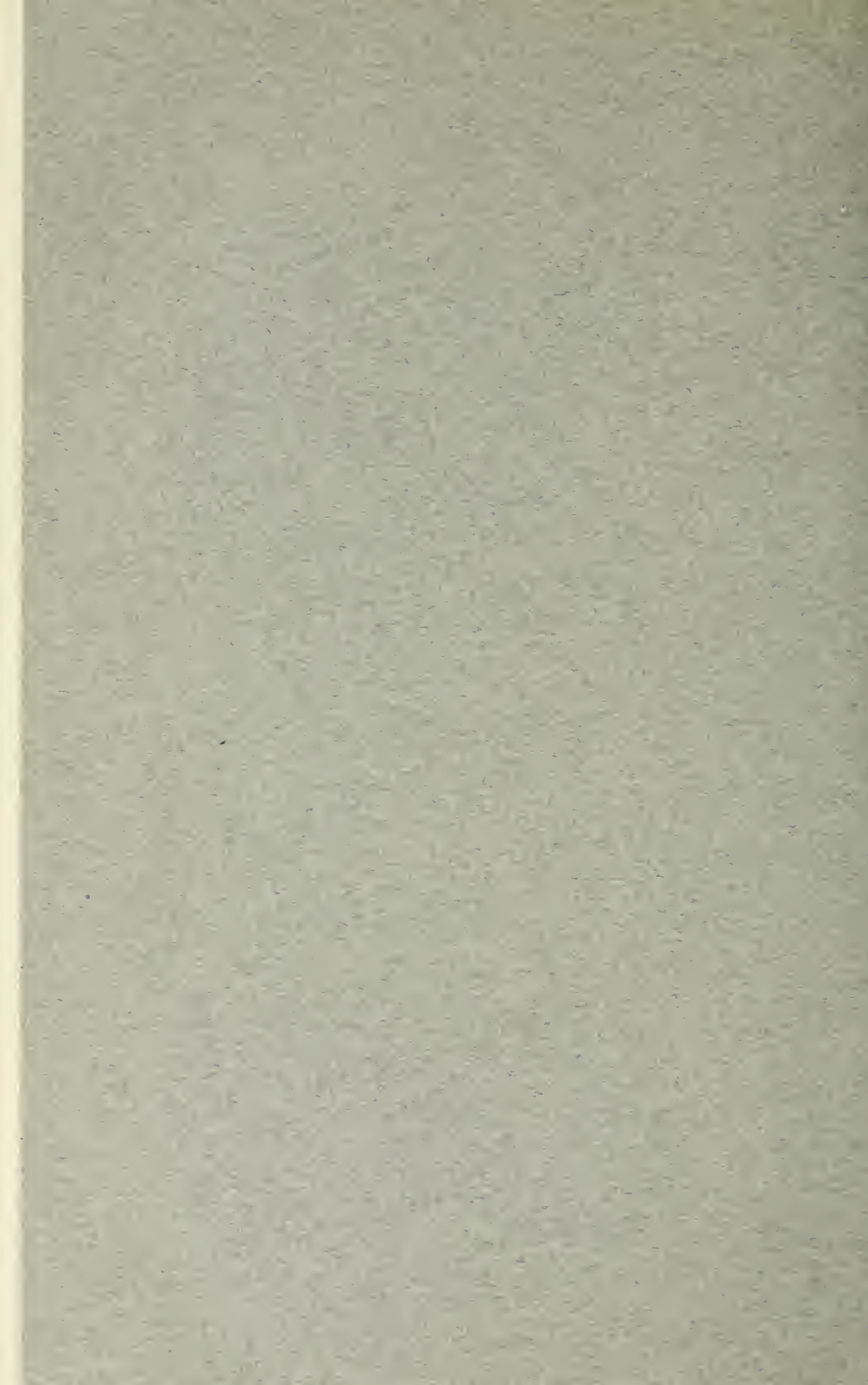
*Appellee.*

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OPENING BRIEF ON BEHALF OF  
APPELLANT.

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*Appellant,*

*vs.*

Charles Atherton,

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## OPENING BRIEF ON BEHALF OF APPELLANT.

### PRELIMINARY STATEMENT.

This is an appeal from a final decree [Tr. p. 21] of the United States District Court, Southern District of California, Central Division, signed, and entered and recorded in the above-entitled cause, on the 5th day of September, 1929, in favor of the defendant (appellee) Charles Atherton, in a suit for infringement of United States Letters Patent for an invention, adjudging that said defendant has not infringed the claims of said letters patent in suit, and for the reason that the registers, claimed as an invention in said letters patent and made by said defendant, were in public use for more than two years prior to the filing of the application for said letters patent, and decreeing that the bill of complaint in said suit be dismissed with costs to said defendant, and that said defendant have execution therefor.

## BRIEF STATEMENT OF CASE.

The plaintiff-appellant, Waterloo Register Company, a corporation, filed its bill of complaint [Tr. p. 3] against the defendant-appellee, Charles Atherton, for infringement of United States Letters Patent No. 1,601,469, for Air Register, granted September 28, 1926, to William L. Carter of Waterloo, Iowa, assignor to the plaintiff-appellant. This case was designated as In Equity No. N-113-H and was filed in the United States District Court for the Southern District of California, Central Division, on June 18, 1928. After issue was joined the case was tried before said court on May 10, 1929, and after hearing all the evidence of both the plaintiff and the defendant, Charles Atherton, the case was submitted on briefs, whereupon the court, on June 24, 1929, entered a minute order in favor of the defendant [Tr. pp. 20-21], and on September 5, 1929, the court signed the aforesaid decree in favor of the defendant (appellee) [Tr. pp. 21-22] which was entered and recorded, on the same date, by the clerk of said court.

## STATEMENT OF FACT.

### THE COMPLAINT [TR. P. 3].

The bill of complaint, in the usual form, alleges, among other essential facts, the granting of United States Letters Patent, No. 1,601,469, for Air Register, to one William L. Carter on September 28, 1926; the assignment of said letters patent to the plaintiff (appellant); the present sole ownership of said letters patent by the plaintiff (appellant); wilful infringement of said letters patent by the defendant (appellee) and notice to the defendant (appellee) of such infringement; and concludes with the



usual prayer for adequate relief, including an injunction, an accounting, damages, costs, etc.

ANSWER [Tr. p. 7].

The answer admits that the defendant, Charles Atherton, is a resident of Los Angeles, in the Southern District of California, Central Division; that the patent in suit was duly granted; and that the defendant received notice of his alleged infringement of the patent in suit, but denies every other material allegation of the complaint; and for further and separate defense the answer alleges, among other defenses, not before this court, public use of the air register, covered by the patent in suit, for more than two years prior to the filing of the application for said patent.

The Patent in Suit.

(Plaintiff's Exhibit 2, Carter Patent No. 1,601,469.)

The patent in suit covers an 'Air Register' for use in a heating or ventilating system for buildings, and the nature of the invention is stated in lines 6 to 14 on page 1 of the patent as follows:

"The general object of the invention is to provide a register in which the shutters, when open, will have the same appearance as fixed bar design or grating, permitting the free passage of a maximum current of hot air therethrough, and will, when closed, present an attractive panel effect with a polished surface, which may easily be kept clean and sanitary. In the preferred form of the invention, the frame containing the shutters is removably secured in an outside frame, which is secured at the outlet of the stack or flue, between abutting ends of the base board."

The shutters are designated in the patent by the numeral 16, while the shutter rods are designated by the numeral 17. The appearance of the fixed bar design when the shutters are open is illustrated in the lower half of Fig. 1 of the patent drawing, while the panel effect with the shutters closed is illustrated in the upper half of said figure.

The frame containing the shutters is designated in the patent by the numeral 12, while the outside frame, in which the shutter frame is secured, is designated by the numeral 10.

Claim 1 of the patent in suit is as follows:

“1. In an air register, the combination of a rectangular frame, equi-distant rods secured thereto and extending across the opening therein, a series of shutters mounted on the respective rods, each shutter having one edge rolled about its rod to form a hinge connection therewith, and the other edge offset to fit beneath the rolled edge of the next shutter so as to present a panel effect when the shutters are closed and present the appearance of a fixed bar design when the shutters are open, one rear corner portion of each shutter being slit longitudinally and bent at right angles to form a projecting ear, a bar having series of projecting pins on which the ears are pivoted, the edges from which the ears are cut forming shoulders engageable by said bar to limit the opening movement of the shutters.”

The above claim, the appellant contends, covers the basic structure of both the appellant's and the appellee's "registers", or what the appellee terms a "louver". [Tr. p. 44.]

Claim 2 covers the structure of said claim 1 in combination with the *outer rectangular frame* (10) having the inner portion of its face depressed to form a seat (11), and means (lugs 13 and screws 14), co-operating with

a peripheral flange, on the inner rectangular frame (12) in which the shutter rods (17) are secured, for removably securing said flange on said seat. The *outer frame* (10) is the *support* for the "register" or "louver". A support is of course necessary to use either appellant's or appellee's register or "louver".

### Defendant's Register or "Louver".

The defendant's register or "louver", Plaintiff's Exhibit 7, contains the same elements, which function the same, and accomplish the same results, as the elements of the plaintiff's register, as disclosed and claimed in the patent in suit, there being only a slight, non-functional and immaterial modification of the form of the shutter hinge rods or pivots in the defendant's "louver".

### Defendant's Defenses.

Since the final decree of the lower court sustained only the defenses of "no infringement" and "prior use", and made no finding as to any of the other defenses of the defendant, none of said other defenses are before this court, and we will therefore consider only the defenses of "no infringement" and "prior use".

NO INFRINGEMENT. In view of the mechanical identity of the defendant's louver, Defendant's Exhibit 7, and the register disclosed and claimed in the patent in suit, as above pointed out, we contend that the defendant failed to establish his defense of "no infringement", and that he infringes the patent in suit.

PRIOR USE. The defense of prior use consisted only of an alleged *single prior use* of the defendant's "louver" by one Emil R. Bossard at Van Nuys, in Los Angeles,

California, since the year 1923; no evidence of any of the other alleged prior uses, set up in the answer, being offered at the trial. For proof of said alleged prior use, the defendant (appellee) offered in evidence his alleged "louver", Defendant's Exhibit D, and *oral evidence only* of very questionable character, that said "louver" was made in the year 1923 and used in the residence of said Emil R. Bossard since that year; *no documentary evidence* whatsoever of the alleged *date of manufacture and use* of said "louver" being offered at the trial by the defendant. We therefore contend that the defendant's evidence failed to meet the strict requirements of the well-established rule as to proof of prior use, and that the defendant failed to establish his defense of prior use.

From the final decree of the lower court [Tr. pp. 21-22], finding no infringement of the patent in suit by the defendant, based entirely upon the defendant's most questionable and unreliable *oral* evidence of his alleged prior use, the plaintiff-appellant takes this appeal on the following assignment of errors.

### ASSIGNMENT OF ERRORS.

[Tr. pp. 131-133.]

#### I.

That the District Court of the United States for the Ninth Circuit, Southern District of California, Central Division, erred in entering any decree in favor of the defendant, Charles Atherton.

#### II.

That said court erred in entering the decree of September 5th, 1929, for the reason that the same is contrary to law.

III.

That said court erred in decreeing as follows:

1. That the defendant, Charles Atherton, has not infringed the claims of the patent in suit and for the reason that the registers made by said defendant were in public use for more than two years prior to the filing of the application for the patent in suit.

IV.

That said court erred in decreeing that the patent in suit is not infringed by the defendant.

V.

That said court erred in decreeing that the patent in suit is not infringed by Exhibit 7.

VI.

That said court erred in not decreeing the patent in suit infringed by the defendant.

VII.

That said court erred in not decreeing Exhibit 7 an infringement of the patent in suit.

VIII.

That said court erred in decreeing that the plaintiff take nothing by this suit.

IX.

That said court erred in decreeing that the bill of complaint be dismissed with costs to defendant in the sum of (\$74.20) to be taxed according to the rules and practice of the court, and that defendant have execution therefor.

X.

That said court erred in not entering a decree for an injunction, costs, profits, and damages, as prayed in the

bill of complaint, against the defendant, for infringing the patent in suit.

### Consideration of Assignment of Errors.

The different assignments of errors above specified will be urged for consideration before this Honorable Court, and certain of the said assignments may be grouped as follows:

1. Assignments I, II, VIII, IX and X which may be briefly grouped to the effect that the lower court erred generally in entering a decree in favor of the defendant-appellee.

2. Assignments I, II, III, IV, V, VI and VII to the effect that the lower court erred in decreeing that the defendant-appellee has not infringed the patent in suit.

3. Assignments I, II and III to the effect that the lower court erred in not finding that the registers made by the defendant were not in public use for more than two years prior to the filing of the application for the patent in suit.

### Issues.

1. Is the final decree of the lower court according to law?

2. Does the defendant infringe the claims of the patent in suit?

3. Have the registers, or "louvers", made by the defendant been in public use for more than two years prior to the filing of the application for the patent in suit?

ARGUMENT.

ISSUE 1.

Assignments of Errors I, II, VIII, IX and X.  
The Lower Court Erred in Not Entering Its Final  
Decree in Favor of the Plaintiff, Because,

*The defendant has admitted the validity of the patent in suit in his bill of particulars, and if the patent is valid the defendant has infringed the patent in suit in view of the mechanical identity of the defendant's register or "louver" and the register disclosed and claimed in the patent in suit, as above pointed out under the heading "Defendant's Register or 'Louver'" and as hereinafter pointed out under the heading Issue 2.*

Paragraph 2 [Tr. p. 17], specification (b) of defendant's answer to plaintiff's demand for bill of particulars is as follows:

"(b) None of the elements of the alleged invention set forth in the claims of said letters patent is new, but the location of the '*projecting ear*' at one of the *rear corners of the shutters is new*. In the *old register referred to in paragraph 1 hereof*, the *projecting ear* is substantially in the center of the end of the shutter and *not at the corner* thereof. Further, the '*shoulders engageable by said bar to limit the opening movement of the shutters*' is new. The said old register has the shoulders and the bar, *but the opening movement of the shutters is not limited by the engagement of the bar and shoulders, as claimed.*"

The court will find, upon examination of Defendant's Exhibit A ("the said old register"), that the projecting ears are *not in the center of the end of the shutters*, but that said *ears are at the corners of the shutters*. Moreover, the court will find that the opening movement of

the *shutters is*, contrary to defendant's above specification, *limited by the engagement of the shutter connecting bar with the shoulders.*

The defendant-appellee has specified one structure in his bill of particulars and offered in evidence an entirely different structure. Which is correct? This is just one illustration of the questionable character of the defendant's evidence.

Defendant's Exhibit A should have been objected to by counsel for the plaintiff and ruled out of the evidence by the court. However, as the lower court made no finding as to whether or when the defendant ever made his alleged "louver," Defendant's Exhibit A, there is, therefore, no issue before this court as to whether defendant's said exhibit anticipates the patent in suit, so we will dismiss Exhibit A without further consideration in this respect.

Referring again to defendant's above specification (b), paragraph 2 of his bill of particulars, it is pointed out that *defendant admits* that the *location* of the "*projecting ear*" (designated 19 in the patent in suit) *is new*, and that the "*shoulders* (designated 22) *engageable by said bar* (designated 21 in the patent) *to limit the opening movement of the shutters*" *is new.*

The defendant (appellee) has condemned himself out of his own mouth. If the projecting ears 19 at one of the rear corners of the shutters and the shoulders 22 engageable by the bar 21 to limit the opening movement of the shutters, are new (and these features certainly are useful), then the patent in suit was duly and regularly granted for a new and useful patentable inven-



tion, and the defendant (appellee) by his own admission is estopped from denying the validity of the patent upon any grounds, including prior use.

The validity of the patent in suit being thus established, and infringement of the patent by the defendant (appellee) being established by the defendant's "louver", Plaintiff's Exhibit 7, which contains all the elements of claim 1 of the patent, *the case might well end here* with a reversal of the lower court in favor of the plaintiff-appellant as prayed in the bill of complaint. Nevertheless, we desire to present the case fully and fairly before the court.

## ISSUE 2.

### Assignments of Errors I to VII Inclusive.

#### The Lower Court Erred in Not Finding That the Defendant Infringed the Patent in Suit, Because

If we apply claim 1 of the plaintiff-appellant's patent in suit (Plaintiff's Exhibit 2) to the defendant-appellee's structure, as shown by the defendant-appellee's register or "louver" (Plaintiff's Exhibit 7), we will find every element of said claim in the defendant-appellee's said register or "louver".

Taking claim 1 of the patent in suit, and dividing up the elements, we have the following:

(a) In an air register, the combination of a rectangular *frame*;

(b) Equi-distant *rods* secured thereto and extending across the opening therein;

(c) A series of *shutters* mounted on the respective rods, each shutter having one edge rolled about its rod to

form a hinge connection therewith, and the other edge offset to fit beneath the rolled edge of the next shutter so as to present a panel effect when the shutters are closed and present the appearance of a fixed bar design when the shutters are open:

(d) One rear corner portion of each shutter being slit longitudinally and bent at right angles to form a projecting *ear*;

(e) A *bar* having series of projecting *pins* on which the ears are pivoted;

(f) The edges from which the ears are cut forming *shoulders* engageable by said bar to limit the opening movement of the shutters.

The defendant-appellee's register or "louver", Plaintiff's Exhibit 7, has all of the above specified elements of claim 1 of the patent in suit, with only the slight, non-functional and immaterial modification of the form of the shutter hinge rods, to wit: the hinge rods of the defendant-appellee's structure being made in two pieces instead of one piece, like the plaintiff-appellant's hinge rods 17, as disclosed in the patent in suit. Nevertheless, one edge of the defendant's shutters is rolled about the two piece pivots, and gives the shutters, when open, the appearance of a fixed bar design or grating, which is mechanically the same as rolling one edge of the shutters about the one piece hinge rods 17 of the patent in suit, to give such appearance, as described in lines 6 to 9 of the patent in suit.

Comparing the defendant-appellee's "louver", Plaintiff's Exhibit 7, element by element, with claim 1 of the patent in suit, we find in defendant-appellee's "louver",

(a) A rectangular *frame*.

(b) *Hinge pivots*, which are the mechanical equivalent of the *hinge rods 17* of the patent in suit.

Although the claims of the patent in suit specify the rods 17 extending across the open space in the rectangular frame 12, there is no mechanical reason for such extension other than to enable the rods to form *pivots* or *hinge rods* for the shutters 16 and to give the shutters, when open, the appearance of a fixed bar design or grating, permitting free passage of a maximum current of hot air there-through. The claims are, of course, to be read in the light of the specification of the patent, which describes, in lines 54 to 58 inclusive, the rods 17, as follows:

“One edge of each shutter is rolled about a rod 17, which is secured to flanges 15 at the top and bottom of the frame, and *constitutes a hinge rod about which the shutter is rotatable.*”

There is therefore nothing in the specification of the patent in suit which limits the pivots or hinges of the shutters to rods “extending across the opening therein” (opening of the frame 12). Moreover, defendant’s counsel has introduced *no prior art* in evidence which was cited by the Patent office, showing that the applicant of the patent in suit had to limit his claims to rods “extending across the opening” in the frame 12 to distinguish the invention from the prior art in order to obtain a patent.

“Limitations in the terms of the claim do not import any limitation in the construction of the claim, in cases where such limitation is *not imposed by the state of the art.*”

Carpenter, in *Sacks v. Brooks*, 74 Fed. Rep. 935.

The patent is therefore entitled to a liberal construction, and when it is considered that the rods 17, regardless of their construction, function to *constitute ordinary hinge rods* about which the shutters rotate, and give the shutters, when open, the appearance of a fixed bar design or grating, permitting free passage of a maximum current of hot air therethrough, it is idle for the appellee's counsel to attempt to read any meaningless limitation of the construction of the hinge pivots into the claims of the patent in suit in order to enable appellee to escape infringement of appellant's patent by a counterfeit structure having all of the elements and which function the same as the elements of the patent in suit and accomplish the same results.

“Infringement is not avoided by mere changes in construction when the same mode of operation is retained and the same result attained.”

Ransome Concrete M. Co. v. United Concrete M. Co., 165 Fed. (No. 6) 914-923.

It is a well established rule of patent law that patents are interpreted according to their position in the arts. A pioneer or basic patent is given a broad interpretation and a wide range of equivalents, while patents for slight, specific improvements on old devices are given a narrow interpretation and a narrow range of equivalents. The patent in suit, while not a pioneer patent in the sense of a patent covering the first air register ever invented, is nevertheless a patent covering something more than merely a slight improvement on an old device, because it embodies several new features, which were entirely original and new in the art at the time the patent was applied for, which features are: the fixed bar design when the

shutters are open to permit passage of a maximum current of hot air through the register; the panel appearance of the shutters when closed; and the narrow width of the shutters which take up little room so as not to cut off the current of air in the throat of the register box when the shutters are open or partly open, whereby the current of hot air is admitted through the register box unrestricted. These features are of the highest practical utility and a very substantial contribution to the art. The patent in suit may, therefore, at least be roughly classified as a patent falling between a pioneer patent and a specific improvement patent, entitled to a substantial range of equivalents.

Hopkins on Patents, Vol 1, Sec. 101, p. 185, states the rule applicable to patents such as the patent in suit as follows:

“But what of those patents that are within neither of these classes (pioneer or specific)? There are necessarily many which are of considerable, many of very substantial, advancement to their arts which are *entitled to an expanding range of equivalency* according to their standing in those arts. *This is the established rule.* In speaking of a sewing machine patent, Judge Vandevanter has said, ‘*We regard it as neither primary nor a slight improvement on the prior art, but possessing enough of patentable novelty to command a reasonable range of equivalents.*’”

Lewis Blind Stitch Mach. Co. v. Premium Mfg. Co., 90 C. C. A. 310, 163 Fed. Rep. 950-954.

“To be entitled to the benefit of the doctrine of equivalents, it is not essential that the patent shall be for a pioneer invention in the broad sense of the term.”

Bundy Mfg. Co. v. Detroit Time-Register Co., 94 F. R. 524.

Walker on Patents, Sixth Edition, Sec. 416, states the rule as follows:

“But a patentee is not to be denied the benefit of the doctrine of equivalents to the extent necessary to protect his actual invention, although the invention may be a narrow one.”

The defendant attempts to avoid infringement of the claims of the patent in suit by merely using *two* nails for pivoting each shutter instead of *one* hinge rod as disclosed in the patent. In the defendant's louver, Defendant's Exhibit A and Plaintiff's Exhibit 7, one nail extends through the upper member of the frame into the upper portion of the rolled edge of each shutter, while another nail extends through the lower member of the frame into the lower portion of the rolled edge of the shutter, instead of a single rod extending entirely through the rolled edge of the shutter. The *two nails* of each shutter of the defendant's "louver", however, *perform the same function in the same manner and accomplish the same results as the single rod 17* of each shutter of the patent in suit, namely *serve as a pivot* for the shutter and give the shutters, when open, the appearance of a fixed bar design or grating to permit a maximum amount of hot air to pass therethrough. The defendant's *two nails* are therefore the *mechanical equivalent* of the *single rod 17* of the plaintiff's patent.

“It is, therefore, safe to define an equivalent as a thing which performs the same function and performs that function in substantially the same manner as the thing of which it is alleged to be an equivalent.”

Sec. 415, Walker on Patents, Sixth Edition.

“The substantial equivalent of a thing is, in the sense of the patent law, the same as the thing itself.

Two devices which perform the same function in substantially the same way, and accomplish the same result, are, therefore, the same, though they may differ in name and *form*."

Machine Co. v. Murphy, 97 U. S. 120.

The slight change in the hinge pivots or rods, which the defendant-appellee has made, is at best only a change of *form*—a mere *subterfuge*—which does not avoid infringement of the patent in suit.

"Upon well established principles of patent law, a change of *form* and not of *substance* constitutes no defense to a bill for an infringement."

Morey v. Lockwood, 75 U. S. 230; 19 L. Ed. 339.

"A mere *subterfuge* resorted to to avoid infringement does not avail as a defense."

Rose v. Hirsh, 77 Fed. 469, 23 C. C. A. 246.

"When the court is convinced that a meritorious invention has been made, it should not permit infringers to evade the patent on narrow and technical grounds."

Cimiotti v. American, 115 F. 498, 53 C. C. A. 230.

INFRINGEMENT CANNOT BE AVOIDED BY THE DEFENDANT BY MAKING HIS SHUTTER PIVOTS IN TWO SECTIONS INSTEAD OF ONE AS ILLUSTRATED BY THE PATENT IN SUIT.

Hopkins on Patents, Vol. 1, page 339, Sec. 270, states the rule as follows:

"Nor (is) the charge of infringement averted by the division of *one* element into *two*, if the two resulting parts *jointly act* to produce the *unitary result* of the single element."

The rule is further stated in the following cases;

“Infringement is not avoided by simply dividing *one* element of the patent into *two* parts, so arranged that the action of one necessarily causes the action of the other in the same way as though they were one, and their combined operation performs the same function and produces the same results as the device of the patent.”

Westinghouse v. New York Air Brake Co., *et al.*,  
59 Fed. Rep. 581.

Shortridge v. Lindsay, 6 Fed. Rep. 510-513.

“Infringement cannot ordinarily be escaped by merely *cutting in two* a device *made in one piece*, or by making integral an article formerly made in two.”

Standard Caster and Wheel Co. v. Caster Socket  
Co., 113 Fed. Rep. 162.

The above rule is stated inversely by the United States Supreme Court in the case of Carey v. Houston & T. C. R. Co., 37 L. Ed. 1039-1041, as follows:

“It involves no invention to cast in *one* piece an article which has formerly been cast in *two* pieces.”

(c) In the defendant's louver (Plaintiff's Exhibit 7) there are *shutters* each of which has one edge rolled about its pivot to form a hinge connection therewith, and the other *edge offset to fit beneath the rolled edge of the next shutter*, so as to present a *panel effect* when the shutters are closed and present the appearance of a *fixed bar design* when the shutters are open, as specified in the claims of the patent in suit.

(d) (e) (f) The defendant's louver also has the remaining structure of the claims of the patent in suit, namely, “one rear corner portion of each shutter being



slit longitudinally and bent at right angles to form a *projecting car*. (d) a bar (e) *having series of projecting pins on which the cars are pivoted, the edges from which the cars are cut forming shoulders* (f) *engageable by said bar to limit the opening movement of the shutters*".

In the defendant's "louver", Defendant's Exhibit A, and Plaintiff's Exhibit 7, there is no question about the engagement of the shutter connecting bar with the shoulders formed at the outer corners of the shutters, whereby the opening movement of the shutters is limited. Defendant Atherton further testified that there is no difference in the mechanical structure and the principles of operation of that register (Defendant's Exhibit A) and the registers (Plaintiff's Exhibit 7) which he is today manufacturing. [Tr. p. 51.]

Defendant Atherton testified [Tr. pp. 52-53] that the end of the shutter connecting bar struck against the outside frame of the register to limit the opening movement of the shutters, instead of the bar engaging the shoulders at the outer corners of the shutters to limit said opening movement, as specified in the patent in suit. However, the defendant's structure has a bar and shoulders on the shutters which would be engaged by the bar to limit the opening movement of the shutters, if such movement were not first arrested by the engagement of the end of the bar against the outside frame of the register and defendant's counsel [Tr. pp. 65-66] made the following admission:

"Perhaps in some association if you take Mr. Atherton's louvers, as he calls them, one could throw that thing around maybe far enough to *make those shoulders engage*."

Having the bar and shoulders capable of limiting the opening movement of the shutters and in fact accomplishing such result (Defendant's Exhibit A), *the defendant's "louver" embodies the structure of the patent in suit and infringes the claims of the patent.* Infringement, however, is not avoided by using the *complete structure* of a patent and *adding* something to it, even if what is added *impairs* the function of an element of the patented invention, such as the defendant's shutter bar which he alleges strikes against the outside frame of the register and prevents the bar from engaging the shoulders at the outer corners of the shutters and limiting the opening movement of the shutters, as illustrated in the patent in suit. *The use of the claimed structure of the patent in association with any other element infringes the patent.*

*Walker on Patents*, Sec. 409, Sixth Edition:

"*Addition to a patented machine or manufacture does not enable him who makes, uses or sells the patented thing with the addition, to avoid a charge of infringement. (Western Electric Co. v. LaRue, 139 U. S. 607, 1891.) This is true even where the added device facilitates the working of one of the parts of the patented combination, and thus makes the latter perform its function with more excellence or greater speed, or where the added part hinders the patented combination from having some of its minor merits. (Cochrane v. Deener, 94 U. S. 786, 1886.) (Sawyer Spindle Co. v. Morrison Co., 52 F. R. 539, 1892.)"*

"One may not escape infringement by *adding* to or subtracting from a patented device, by changing its form, or by making it more or *less efficient*, while he retains its principle and mode of operation, and attains its result by the use of the same or of equivalent mechanical means."

Lourie Implement Co. v. Lenhart, 130 Fed. 122,  
62 C. C. A.

The case of King Ax Company v. Hubbard, 97 Fed. 795, p. 803, Circuit Court of Appeals for the Sixth Circuit, is in point, the court holding as follows:

“This is an instance, not infrequent in patent litigation, where the infringer has sought to evade the claims of a patent, the substance of which he is appropriating, by deliberately *impairing the function* of one element, without destroying the substantial identity of structure, operation, and result. (Sewall v. Jones, 91 U. S. 171; Coupe v. Weatherhead, 16 Fed. 673; Machine Co. v. Binney, 24 Fed. Cas. 653.) This court, following the Supreme Court, has pointed out in a number of cases that, *the more meritorious the patent, the more liberal will the court be in applying the doctrine of equivalents to cover devices adopted for the purpose of appropriating all that is good in a patent* without rendering the tribute which the patent law was intended to secure, for a temporary period, to those who by their ingenuity have made possible real progress in the industrial arts. Bundy Mfg. Co. v. Detroit Time Register Co., 94 Fed. 524; McCormick Harvesting Mach. Co. v. Aultman, Miller & Co., 37 U. S. App. 299, 16 C. C. A. 259, and 69 Fed. 371; Wells v. Curtis, 31 U. S. App. 123, 13 C. C. A. 494, and 66 Fed. 318; Miller v. Manufacturing Co., 151 U. S. 186, 207, 14 Sup. Ct. 310.”

THE DEFENDANT-APPELLEE, EVEN IF HE MAY HAVE MADE A FEW SLIGHT, IMMATERIAL CHANGES, HE HAS NEVERTHELESS APPROPRIATED THE PLAINTIFF-APPELLANT'S PATENTED REGISTER IN SUBSTANCE AND HAS UNQUESTIONABLY INFRINGED THE PATENT IN SUIT.

“To infringe a patent it is not necessary that the thing patented should be adopted in every particular. *If the patent is adopted substantially by the defendants, they are guilty of infringement.* The question of infringement depends upon whether the plan which the defendant has employed, is *in substance*,

the same as the plaintiff's and whether all the differences which have been introduced are not differences in circumstances not material, and whether it is not in substance and effect a colorable evasion of the plaintiff's patent."

Sewall v. Jones, 91 U. S. 173, 183, 23 L. Ed. 275.

In the case of Stebler v. Riverside Heights Orange Growers' Association, 205 Fed. 735, this court had to say, at page 739:

"One who appropriates another's patented invention, even though he may *add* thereto *another element* to perform an additional function, is guilty of infringement."

Citing numerous cases, including In Cimiotti Unhairing Co. v. American Unhairing Mac. Co., 115 Fed. 498, 504, 53 C. C. A. 230, 236, wherein the Circuit Court of Appeals of the second Circuit used the following language:

"The mere fact that there is an *addition*, or the mere fact that there is an omission, *does not enable you to take the substance* of the plaintiff's patent. The question is, *not whether the addition is material*, or whether the omission is material, *but whether what has been taken is the substance of the invention.*"

The defendant's construction contains *all of the identical elements* of the claims of the patent in suit, and particularly *claim 1*, and the elements of the defendant's "louver" *co-operate and function in the same manner and accomplish the same results* as the elements of the claims of the patent. While the language of the patent may not be in the best technical form, *it clearly comprehends the defendant's structure* when given a reasonably fair construction.

“A patent should be generally construed in a favorable and beneficial sense for the best interests of the patentee.”

Hogg v. Emerson, 6 How. 437, 12 L. Ed. 505.

IT IS SUBMITTED THAT THE DEFENDANT-APPELLEE'S REGISTER OR "LOUVER" UNQUESTIONABLY EMBODIES THE SUBSTANCE OF THE REGISTER COVERED BY THE PATENT IN SUIT, AND THAT THE DEFENDANT-APPELLEE INFRINGES THE PATENT IN SUIT.

### ISSUE 3.

#### Assignments of Errors I, II and III.

The Lower Court Erred in Not Finding That the Registers Alleged to Have Been Made by the Defendant Were Not in Public Use for More Than Two Years Prior to the Filing of the Application for the Patent in Suit, Because

“All tribunals of the land including the United States Supreme Court have always considered the interposition of the *bar of public use* to be *the last refuge of a desperate infringer* and have accordingly laid down *more stringent rules of evidence* than are usually required in a civil suit.”

Journal of the Patent Office Society, Vol. XI, No. 8, Aug., 1929, page 354.

We contend that a fair analysis of the defendant's evidence of alleged prior use will show that his evidence is not within the rules laid down by the courts, and particularly this court.

No evidence whatever of prior use of the “louver”, Defendant's Exhibit A, was offered at the trial by the defendant.

The defendant's evidence of alleged prior public use of a *single* register, Defendant's Exhibit D, consisted *only of oral testimony of three witnesses*, namely, the defendant, Charles Atherton, Emil R. Bossard, and Elizabeth Bossard, the wife of Emil R. Bossard; *no documentary evidence* whatsoever being offered at the trial.

The defendant's "louver", Defendant's Exhibit D, alleged to have been used by Emil R. Bossard since 1923, has no stamp or mark thereon indicating the *time that it was made* or identifying the manufacturer thereof.

Defendant Atherton, when asked on cross-examination if he had any *sales receipts or slips* to show that he sold any registers during the year 1923, testified:

"Well, of course, when I organized the new company my books were turned over to them, and of course *these little day ledgers and things are gone.*"  
[Tr. p. 67.]

Emil R. Bossard, when asked if he had any other way of fixing the alleged date (1923) when he put the furnace, with the defendant's alleged register, Defendant's Exhibit D, in his house, except by the deed to his house, testified:

"That is about the best I can do. *I have no receipts or papers.*" [Tr. p. 78.]

It is most significant that Bossard produced *no building permit or other record of the Building Department* of the city of Los Angeles to show that he installed his alleged furnace and register in his house, which was located in the city of Los Angeles, in the year 1923 [Tr. p. 79], and the absence of such record should be resolved most strongly against the defendant, because a building record would have been the *best* evidence of the fact that the

defendant's alleged "louver" was installed in Bossard's house in 1923, but the defendant has produced only the most *inferior, secondary, oral* evidence of such fact.

The burden of proving the defense of prior use is on the defendant (*Parker v. Stebler*, 177 Fed. Rep. 210, C. C. A. 9th Circuit) and we submit that the rule requires the defendant to prove that a use was lawful, especially the use of heating apparatus such as Bossard's *electrically-controlled* furnace [Tr. p. 59] and the defendant's "louver," which is ordinarily governed by a fire ordinance of the building regulations.

Bossard testified [Tr. p. 79] that he *did not obtain a building permit* to install his *electrically-controlled* furnace, and the defendant's register or "louver", and *the defendant has failed to prove that there was no fire ordinances or other building regulation in 1923 governing the installation of electrically-controlled heating apparatus in the city of Los Angeles, where Bossard's house was located.* [Tr. p. 79.] The presumption is that *there was such an ordinance*, because such ordinances are customary and because Bossard got a permit to install an *electric* hot water heater in his house [Tr. pp. 79-80], and if there was such an ordinance, then *Bossard violated the law, if he installed his alleged electrically-controlled heating apparatus, including the defendant's register or "louver", Defendant's Exhibit D, in his house in 1923, without obtaining a permit, as he testified, or otherwise complying with the fire ordinance. The defendant has therefore failed to prove that Bossard's alleged prior public use was lawful, and the defendant attempting to set up an unlawful use would, of course, have no standing*

before this Honorable Court, because, "HE WHO COMES INTO EQUITY MUST COME WITH CLEAN HANDS."

21 Corpus Juris, section 163, page 183;

Harton v. Little, 188 Ala. 640, 65 S. 951;

Bair v. Howison, 154 Ala. 359, 45 S. 668.

"The maxim (clean hands) imposes itself alike upon *one who defends* and one who prosecutes a suit in equity."

21 Corpus Juris, Sec. 170;

Com. v. Filiatrean, 161 Ky. 434, 170 S. W. 1182.

The case of H. A. Laver v. Mary Pickford Fairbanks and Denis F. O'Brien, administrators of the estate of Charlotte Pickford Smith, decided Dec. 13, 1929, by the Superior Court of Los Angeles county, California, is in point. The Architectural Act of California requires that an unlicensed architect who draws plans must notify the persons for whom he draws them that he is unlicensed. As Mrs. Smith is dead, the architect, Laver, could not prove that he had given her the required notice, and the plaintiff was non-suited. The court said:

"The court feels that unless you comply with the law it cannot grant you any relief. The court is of the opinion you have not made out a case, especially as to the Architectural Act. There is *no proof here that you have followed the terms of the act.*"

The case of D. C. Rudolph v. Golden, 39 App. 230, is also illustrative of the said equitable maxim, which held:

"One who, without procuring the requisite permission from the public authorities, suspends wires over a public street, for the purpose of transmitting electric current from his plant to be used in lighting stalls on the sidewalk, is not entitled to invoke the equitable aid to restrain the authorities from inter-



ferring with the wires. \* \* \* Complainant is here in the position of one violating the law, and is not, therefore, in position to invoke equitable relief."

See also:

Castroville Co-operative Creamery Co. v. Col., 6 Cal. App. 533, 92 Pac. 648;

and

Warden v. California Fig Syrup Co., 187 U. S. 516—1902, 47 L. Ed. 382, 23 Sup. Ct. 161.

It is submitted that proof of the legality of a prior public use to invalidate U. S. Letters Patent, cannot be left to inference, especially if the alleged use is apparently illegal, because a *valid* prior public use of a patented invention is required to be proven by the defendant beyond *all* reasonable doubt, and that there would at least be grave doubt in the instant case of the legality of Bossard's alleged prior public use, if such use should be considered as otherwise proven.

"An anticipation (prior public use) must be proven by *evidence so cogent as to leave no reasonable doubt* in the minds of the court."

Carson Inv. Co. v. Anaconda Copper Mining Co., 26 F. (2nd) 651 (9th Circuit).

"In a patent infringement suit, defendant must prove defense of prior use with *certainty* and beyond *all* reasonable doubt."

Starr Can Opener Co. v. Turner and Seymour Mfg. Co., *et al.*, 35 F. (2nd) 254.

"Defendant in patent infringement suit has burden of proof to establish prior use, and *every doubt should be resolved against him.*"

American Fruit Growers v. Brogdex Co., 35 F. (2nd) 106 (C. C. A., 3rd Circuit).

Plaintiff (appellant) offered in evidence an application for a building permit, designated Plaintiff's Exhibit 9 for Identification, which was objected to by counsel for the defendant (appellee) and ruled out of the evidence by the court. [Tr. pp. 101, 102, 104, 107 and 108.] An exception was taken by counsel for the plaintiff (appellant) to the ruling of the court on said exhibit. [Tr. p. 108.]

Plaintiff's Exhibit 9 for Identification is an application by one George F. Martin for a building permit, dated May 14, 1925, to build one room 10'x6' and to excavate a cellar for a house located at #13015 East Sherman Way, Los Angeles, California, on property described as lot 119, Tract 1000. [Tr. pp. 101-102.]

The number of Bossard's house and the legal description of his property are the same as given in Plaintiff's Exhibit 9 (Ident.) [Tr. pp. 98-99], but the name of the street, East Sherman Way, given in said exhibit was changed [Tr. pp. 55, 98 and 105] after the date of said exhibit and before the trial of this cause, to Chandler boulevard, and Bossard's address at the time of the trial was #13015 Chandler boulevard. Moreover, the legal description of the property given in Plaintiff's Exhibit 9 (Ident.) corresponds to the legal description of Bossard's property on record in the Engineering Department of the City of Los Angeles [Tr. p. 98] and to the legal description given in Bossard's deed [Tr. p. 99]. It is true that the name George F. Martin appears as owner of the property on said exhibit, but the same name appears as the contractor, and the information of witness Franklin from the Building Department was that the contractor evidently put his name on the application also as owner, [Tr.

p. 102] which is very often done by the contractors who build and sell houses. However, the discrepancy in the name of the owner does not change the identity of the address and description of the property given in said exhibit with that on record in the Engineering Department of the City of Los Angeles, nor the identity of the description of the property given in said exhibit and that given in Bossard's deed. [Tr. pp. 98 and 99.]

The point of Plaintiff's Exhibit 9 (Ident.) is that it is a *public record* and *documentary* evidence, and the *best* evidence of the fact that a cellar was placed in the house in May, 1925, at #13015 East Sherman Way (which was later changed to Chandler boulevard), Van Nuys, in Los Angeles, California, on lot 119, *Tract 1000*, and that such evidence is superior to the *secondary* evidence, Bossard's *oral* testimony, that he put the cellar in his house at #13015 Chandler boulevard, lot 119, Tract 1000, in 1923 [Tr. p. 83] for his furnace, which supplied hot air through the alleged register or "louver", Defendant's Exhibit D; and if Bossard's cellar was not put in his house until 1925, then his furnace and the *defendant's alleged "louver"* could not have been installed until 1925, which is not two years prior to the filing of the application for the patent in suit on June 7, 1926. The admission of Plaintiff's Exhibit 9 (Ident.) in evidence would have completely demolished the defendant's defense of prior use and we submit that our point in offering in evidence said exhibit was well taken and that the refusal of the court to admit said exhibit in evidence, especially after witness Franklin offered to go on the witness stand and testify that he found only *one cellar* in Bossard's house, when he called at Bossard's house, was the *grossest kind of prejudicial error* to

the plaintiff on the part of the trial court. [Tr. pp. 107 and 109.]

Bossard, referring to a deed, testified that *he bought his home in 1922, one year after he moved in*, and, without any other memoranda, testified that he installed his furnace and the defendant's alleged "louver", Defendant's Exhibit D, in his house, one year later in May, 1923. [Tr. pp. 74, 77 and 78.]

Bossard's wife, Elizabeth Bossard, when asked how long she had lived in her home, testified:

"Since 1922, or I think it is 1922. We lived there one year before we bought the place. *We bought it in 1923.*" [Tr. p. 85.]

The above testimony of Mrs. Bossard is a perfect example of the *fallibility* and *unreliability* of *oral* testimony. The court will note a *difference of a whole year between the testimony of Bossard and that of his wife, as to the time that they moved into their house and a difference of a whole year as to the time that they bought their home.* Which is correct? If Bossard's testimony, that he moved into his house in 1921, one year before he bought it in 1922, according to his deed, is correct, then Mrs. Bossard's testimony that they lived in their house since 1922 and bought it in 1923 is incorrect. Moving into the house and buying the house were far more important events to Mrs. Bossard than the alleged installation of the defendant's "louver" in her house and if she was mistaken by a whole year as to events of considerable importance to her, what credibility can be given to her testimony as to an event of considerably less importance to her such as the alleged installation of the defendant's louver in her house which she testified so glibly was installed in her house in

1923? [Tr. p. 86.] Mrs. Bossard's ready memory regarding the alleged installation of the defendant's "louver" in her house in the month of May, 1923, [Tr. p. 86] bears all the earmarks of coaching and prompting. We submit that Mrs. Bossard's testimony has not satisfactorily corroborated the testimony of her husband, Emil R. Bossard. Moreover, if Mrs. Bossard's memory regarding events six years past, was so obviously defective, what reason is there to assume that her husband's memory was any better than hers, and especially when Bossard could not recall that the property on which his house is located had an address, #13015 East Sherman Way, in 1925 [Tr. p. 84] which was shown by the Building Permit Application, Plaintiff's Exhibit 9 for Identification, to be a matter of public record? [Tr. pp. 98 and 101.] Said exhibit was certainly better evidence of said address than Bossard's oral testimony and we submit that it should have been admitted at least to show the general unreliability of Bossard's testimony.

The unsupported *oral* testimony of witnesses as to events of no great importance alleged to have taken place five or six years past such as the alleged installation of the defendant's "louver" in Bossard's house in 1923 cannot be relied upon with any reasonable degree of certainty. The following cases are in point:

*"Five witnesses, testifying more than five years after the event fix the date upon which a car was first equipped with racks connected by the Downey hinge as February or late January, 1923. The only aids to their memory are the recollection that the equipment of the car with the hinge was within a short time, a week or ten days, after the inspection of the racks in the yard, and a further recollection that it was before the completion of a certain car shed that was finished between the middle and the 25th of February, 1923.*

“I do not question the honesty of a single one of these witnesses. Yet, before the court is permitted to find a prior public use, it must be satisfied ‘by *evidence so cogent as to leave no reasonable doubt in the mind of the court*, that the transaction occurred substantially as stated.’ *Deering v. Winona Harvester Works*, 155 U. S. 286, 301. *Human memory is far from infallible. In the matter of dates, experience has found it especially imperfect.* *Brooks v. Sacks*, 81 Fed. 403 (C. C. A., 1); *McArthur v. Sears*, 21 Wend. (N. Y.) 190, 192; *Coble v. Grant*, 3 N. J. Eq. 629, 63.

“Other things being equal, the clarity and certainty of memory with respect to an occurrence vary with its recency. It is well known that *memory frequently tends to confuse the dates and relative times of the happenings of similar or related events. To require the unaided memory to fix with absolute precision the particular month in which a certain event took place more than five years past imposes upon it a task for which it is seldom equipped.* Again, it is not possible to conclude with reasonable certainty that the association of the completion of the car shed and the Downey hinge in the minds of the witnesses did not arise from the advent of the Downey hinge and the yard test of the two hinges, rather, than from the equipment of the first car with that hinge. \* \* \* *I think the patent in suit is valid.*” *John A. Massie, Trustee, v. Fruit Growers’ Express Company*, Equity 673, District Court for the District of Delaware, reported in the *United States Patents Quarterly*, Volume 1, 1929, March 4—June 4, Page 85. (See also *Brooks v. Sacks*, 81 Fed. 403 (C. C. A., 1); *McArthur v. Sears*, 21 Wend. (N. Y.) 190, 192; *Coble v. Grant*, 3 N. J. Eq. 629, 63.)

“Upon the issue of anticipation and prior use the defendant must prove beyond reasonable doubt. *In the absence of contemporaneous records, verbal or structural, cases are rare, indeed, where oral testimony can be regarded as sufficient to remove probability of error in fixing the date of the alleged anticipation.* \* \* \* In weighing such testimony the

recollection of honest witnesses, endeavoring to remember transactions *long out of mind, is regarded as peculiarly subject to the influence of suggestion inevitable in any attempt to aid the witness in recalling facts of which proof is eagerly sought. Something more than oral testimony, even from witnesses of the highest character, conscientiously endeavoring to tell the truth is required where the possibility of mistake in recollection is apparent.*"

Franc Strohmenger & Cowan v. Arthur Siegman,  
25 F. (2nd) 108.

Witness *Chester*, who was in partnership with the defendant Atherton during the year 1923 [Tr. p. 110] when Atherton claims to have made his louver, (Defendant's Exhibits A and D) testified that *he was in Atherton's shop frequently [Tr. pp. 113 and 114] during that year and, as a tool and die maker, was interested in articles requiring tools and dies for their manufacture, such as Atherton's alleged louver, but that he (Chester) never saw Atherton at work on his alleged louver, Exhibits A and D, or any other louver in 1923 and that Atherton had no suitable punch press nor any other machines in his shop during that year with which he could have made his alleged louver, Exhibits A and D. [Tr. pp. 111 and 117.]*

Harold G. Wyson, son-in-law of the defendant Atherton, testified that he worked for Atherton in 1923 doing installation work; that *he was in Atherton's shop every day during that year [Tr. pp. 119-120]; that he was around Atherton and closely associated with him all the time from 1923 to 1926 [Tr. p. 121]; that he never saw one of Atherton's registers or louvers in 1923 [Tr. p. 119]; and that the first time he ever saw one of Atherton's louvers was in 1926 in the factory of the Remote*

Control Valve and Manufacturing Company, [Tr. p. 121] and this was *after the time appellant started to manufacture its register in the fall of 1924*, [Tr. p. 32] and about the time Atherton had heard of the Waterloo Register Company, the plaintiff-appellant herein. [Tr. p. 60.] *The year 1926 (when the patent was granted) is the earliest date proved that Atherton could have made his louvers, because it was that year that Atherton first had dies made to produce "louvers,"* [testimony of Wayne Summerville, Tr. p. 123] *there being no evidence that any dies were made for Atherton's alleged "louver" prior to the year 1926.*

Atherton's failure to produce a single mechanic, workman or other competent witness who worked in his shop to corroborate him as to the time (1923) when he testified he produced his "louver," Defendant's Exhibits A and D, speaks most convincingly for itself.

The fact that neither Chester, Atherton's partner, nor Wysong, Atherton's son-in-law, who were most closely associated with Atherton in 1923, knew anything at that time about Atherton's alleged "louver", Defendant's Exhibits A and D, throws grave doubt, to say the least, upon the existence of said louver at that time or prior to 1926, when Wysong first saw the "louver" (the year 1926 being the year the patent in suit was granted).

*"Where a machine would naturally be known to more than a few observers, the fact that it is claimed to have been known to but few at a particular time, throws doubt upon its existence at that time."*

Knickerbocker Co. v. Rogers, *et al.*, 61 Fed. 297.



Chester contradicted Atherton flatly in swearing that Atherton had no machines in 1923 to produce "louvers" and that he was in Atherton's shop frequently that year [Tr. pp. 70 and 113-114] and Wysong contradicted Atherton flatly in swearing that he was employed by Atherton and was in his shop every day in 1923 [Tr. pp. 71 and 119-120]. Chester furthermore testified that he knew *Atherton's general reputation* in the community for *truth, honesty and integrity* and that it *was very bad*. [Tr. pp. 111-112.] Chester's testimony as to Atherton's reputation was not refuted. Moreover, the fact that Wysong testified against his own father-in-law, Atherton, is *mute evidence of the fact that Atherton's reputation for truth, honesty and integrity is not held in high esteem by his own son-in-law, Wysong*. Chester's and Wysong's testimony destroy the credibility of Atherton's testimony, and it is submitted that *Atherton's testimony* from beginning to end, *smacks rankly of perjury*.

The testimony of Herbert Lindsay was of no evidentiary value whatever. His memory, on the whole, was very imperfect. He did not *describe the construction* of the "louver" which he said Atherton showed him in 1923, and he did not *positively* identify Defendant's Exhibit A as such "louver", because there is *no identification mark on it*. [Tr. pp. 89-90.] Lindsay also failed to identify positively, Defendant's Exhibit B, [Tr. p. 90] which exhibit, moreover, is neither a register nor a "louver" and does not embody the invention of the patent in suit. Defendant's Exhibit B is an automobile ventilator. It was not set up in the answer or in the defendant's bill of particulars, nor was any notice of it given to plaintiff within thirty days before the trial as required by section 4920 of the U. S.

Patent Laws, Revised Statutes, Title XL. Lindsay's testimony that he saw the "louver", Defendant's Exhibit D, taken out of Bossard's house on *May 8, 1929*, nearly three years after the patent in suit was granted, proved nothing at all regarding the alleged *time of installation* or *prior use* of said "louver". [Tr. p. 92.] Lindsay's testimony regarding Defendant's Exhibits A, B and D failed absolutely to corroborate Bossard's testimony regarding prior use of Defendant's Exhibit D.

Lindsay was one of the witnesses alleged in the answer as having used the plaintiff's register more than two years before the application for the patent in suit, but it is rather singular that he gave no testimony of such use when he was on the witness stand. *Lindsay's failure to testify as to his alleged prior use is evidently another illustration of the fallibility of human memory, because the defendant's counsel would hardly have overlooked such valuable testimony if the witness could have given it.*

A rather significant fact regarding Atherton's alleged prior inventorship and prior use of the plaintiff's register, covered by the patent in suit, is that he failed to patent his alleged "louver" or take any steps to protect the same, although he was familiar with the patent laws and the value of patents because he had patented a valve and was manufacturing the valve under a patent in 1923. [Tr. pp. 53 and 70.]

"Another circumstance seems to us as having *much weight* in this connection. \* \* \* *If Davis was the inventor of the wire motion applied to these looms, why did he never apply for a patent for it?* He was already a patentee of a different and inferior apparatus. He knew all about the method of going about to get a patent. He belonged to a profession which

is generally alive to the advantages of a patent right. On the hypothesis of his being the real inventor his conduct is inexplicable."

Webster Loom Co. v. Higgins, 105 U. S. 580-595,  
26 L. Ed. 1177 (holding Webster to be the first  
inventor).

We submit that the testimony of Emil R. Bossard was not satisfactorily corroborated by the oral testimony of the defendant, Charles Atherton, Elizabeth Bossard and Herbert Lindsay in view of the fact that Atherton's testimony was nullified by the testimony of witnesses Chester and Wysong; that Mrs. Bossard's memory proved to be wholly unreliable and that Lindsay *gave no testimony* regarding the alleged use of the defendant's "louver" in Bossard's house *prior to the patent in suit*, as above pointed out.

"Prior use of patent, not shown by documentary or *satisfactory oral corroboration*, will not be held to anticipate. \* \* \*

The witnesses Walsh, Eartz, Everson and Cash testified that they *never saw* anything like the white-coated pistachio nuts in question until they were brought to their attention by the Zaloom concern in 1921.

None of the alleged prior uses were proven to my satisfaction *beyond a reasonable doubt*, and while there is no fixed rule, and much depends on the peculiar circumstances of each case, yet in none of the instances of alleged prior use was there documentary corroboration or even *satisfactory oral corroboration*; *therefore none of them anticipate*.

There has been acquiescence in the validity of the patent, and it has to a very large extent displaced the prior art process and product; in fact, the *defendant pays it the flattery of imitation*."

Zenobia Co., Inc., v. Shuda, 30 Fed. (2nd) 948.

The total *absence of documentary evidence* and the failure of the witnesses Atherton, Elizabeth Bossard and Lindsay to corroborate Emil R. Bossard by *satisfactory oral testimony*, reduces the defendant's evidence of alleged prior use to the *oral testimony* of only *one witness*, namely, Emil R. Bossard, which is *insufficient to prove* the defendant's alleged *prior use*.

The rule in point is stated in Walker on Patents, Sixth Ed., Vol. 1, p. 142, sec. 116, as follows:

“The *unsupported oral testimony of one witness is seldom strong enough to negative novelty* of the patent beyond a reasonable doubt.”

The following celebrated Brake Beam Case, decided by Justice Sanborn, is in point:

“Wood, another witness for the appellee, made a drawing of this brake beam in 1898 and then the *brake beam* and the drawing *were offered in evidence*.  
\* \* \* The brake beam which had been under the car at Decatur in 1898 was shown to him and he testified that he recognized it and that he had bored a hole in it in 1874.

“The claim of the beam to antiquity rests on the testimony of one witness that *he identified a hole in it in 1898 which he bored in 1874* and the use of such beam by the Wabash Railroad Company at that time is sustained by the testimony of but one other witness to the effect that *beams like this one were in use at that time*. *The solemn grants of great franchises cannot be stricken down by testimony so flimsy and unsatisfactory*. The memory of men is too brief and fleeting, too easily swayed by chance and by interest, to permit the *recollection of one or two witnesses*, prompted by presently prepared pictures of proof desired, to condition the validity of valuable patents that have stood unchanged for years. *Unsupported oral testimony of a prior use is always open to suspicion*,

and it cannot prevail over the legal presumption of validity which accompanies the patent, unless it is sufficient to establish such use beyond a reasonable doubt. The testimony relative to the use of this Wabash beam is not of that character and it will not be further considered."

National Brake Beam Co. v. Interchangeable Brake Beam Co., 106 Fed. Rep. 703.

THE PRESUMPTION OF VALIDITY OF UNITED STATES LETTERS PATENT CAN BE OVERTHROWN ONLY BY PROOF OF INVALIDITY BEYOND ALL REASONABLE DOUBT. The following authorities for this rule of evidence are here cited:

"Either *Letters Patent*, or such a copy thereof, is *prima facie evidence of the validity* of the Letters Patent." (Citing nine cases.)

Walker on Patents, Sec. 535, Sixth Ed..

Cantrell v. Wallick, 117 U. S. 689, 6 Sup. Ct. 970, 29 L. Ed. 1017.

"The burden of proof of a want of novelty rests upon him who avers it, and every reasonable doubt should be resolved against him. Novelty can only be negated by proof which puts the fact beyond a reasonable doubt."

Walker on Patents, Sixth Edition, sec. 116.

"The patent in suit being *prima facie* evidence that the applicant for that patent was the *first* inventor, the *burden of proof under this defense* (prior use) *lies with a degree of weight upon the defendant.*"

Hopkin's on Patents, p. 419.

"The *burden of proof* to establish a defense of prior use to invalidate a patent *rests upon the defendant.*"

Parker v. Stebler, 177 Fed. Rep. 210 (C. C. A., 9th Circuit).

*“Evidence of doubtful probative force will not overthrow the presumption of novelty and originality arising from the grant of letters patent for an invention. The defense of want of novelty or originality must be made out by proof so clear and satisfactory as to remove all reasonable doubt.”*

Bell Telephone Case v. American Telephone Co.,  
*et al.*, 22 Fed. Rep. 309.

“The general rule that a person who attacks the validity of a patent issued to another must make out his case by *clear and satisfactory proof*, or by *proof beyond a reasonable doubt*, will not be gainsaid.”

Wilson & Willard Mfg. Co. v. Bole, 227 F. R. 607  
(9th Circuit).

*“Every reasonable doubt should be resolved against one attacking the validity of a patent, particularly when the attack is based on oral evidence of facts long past relied on to prove prior use.”*

Searchlight Horn Co. v. Victor Talking Machine Co., 261 F. R. 395 (9th Circuit).

UNSUPPORTED ORAL TESTIMONY OF PRIOR PUBLIC USE OF AN INVENTION IS RARELY STRONG ENOUGH TO OVERTHROW THE STRONG PRESUMPTION OF VALIDITY OF UNITED STATES LETTERS PATENT. The leading authority for this salutary rule of evidence is the celebrated Barbed Wire Case decided by the United States Supreme Court and followed by a long line of judicial decisions, which is quoted here as follows:

“We have now to deal with certain unpatented devices, claimed to be complete anticipations of this patent, the existence and use of which are proven only by *oral* testimony. In view of the unsatisfactory character of such testimony, arising from the forgetfulness of witnesses, their liability of mistakes, their proneness to recollect things as the party calling them

would have recollected them, aside from the temptation to actual perjury, courts have not only imposed upon defendants the burden of proving such devices, but have required that the proof shall be *clear, satisfactory, and beyond a reasonable doubt*. Witnesses whose memories are prodded by the eagerness of interested parties to elicit testimony favorable to themselves are not usually to be depended upon for accurate information. The very fact, which courts as well as the public have not failed to recognize, that almost every important patent, from the cotton gin of Whitney to the one under consideration, has been attacked by the testimony of witnesses who imagined they had made similar discoveries long before the patentee had claimed to have invented his device, had tended to throw a certain amount of discredit upon all that class of evidence, and to demand that it be subjected to the closest scrutiny. *Indeed, the frequency with which testimony is tortured, or fabricated outright, to build up the defense of a prior use of a thing patented, goes far to justify the popular impression that the inventor may be treated as the lawful prey of the infringer.* The doctrine was laid down by this court in *Coffin v. Odgen*, 95 U. S. 18 Wall, 120, 123, (21:621-623), that, 'the burden of proof rests upon him,' the defendant, 'and every reasonable doubt should be resolved against him.' "

The Washburn and Moen Mfg. Co., *et al.*, v. The Beat 'Em All Barbed Wire Co., *et al.*, 143 U. S. 154.

In the case of *Carson Inv. Co. v. Anaconda Copper Mining Co.*, *supra*, this court said:

"We are mindful that the evidence as to prior use is conflicting, and that there is testimony that there was a practice of side charging in the smelters at Dollar Bay. But in patent litigation the mere fact that there is a serious conflict in the evidence as to prior public use, and that the District Court has made its findings in favor of defendants in conformity to the evidence on that issue, does not present

an instance where the appellate court must adopt the findings of the trial judge. An anticipation must be proven by evidence so cogent as to leave no reasonable doubt in the minds of the court, and, if the evidence in support of the issue fail to measure up to that standard, the law will not uphold a conclusion that prior use has been proven."

We contend that in view of the meagre, questionable and unsatisfactory character of the defendant-appellee's oral evidence, the *introduction in evidence* of the defendant's prior use, *Exhibit D*, is not sufficient to prove the alleged prior use of said exhibit, without *documentary* evidence as to the *time* of its alleged use, because there is no *mark* nor anything *inherent in said exhibit* itself which indicates the *time* that it was *made or used*. The *exhibit itself* proves nothing but that it was made at *some* time, but *not that it was made and used more than two years prior to the application for the patent in suit*, which is all-important in this litigation.

In the following cases, although *prior use exhibits* were introduced in evidence, the court held that, *in view of the absence of documentary evidence, the alleged prior uses were not proved, as required, beyond a reasonable doubt.*

In the case of *Block v. Nathan Anklet Support Co.*, 9 F. (2nd) 311 (C. C. A. 2nd Circuit, June 16, 1925), Circuit Judge Hand held as follows:

"But, because of the reasons we have already given, it seems to us that the *date of its* (Exhibit W) *production is not inalterably fixed*. While we have no doubt that Marteau and Nathan were at work on their new insoles in November and December, 1918, it is quite impossible from any *documen-*



*tary evidence, to say when they first made the asymmetrical pads. It is quite likely—indeed, we think it extremely probable—that they are right in saying that Exhibit W was in existence before January 16, 1919; but in such cases probability, even extreme probability, is not enough. The proof must be as absolute as in a criminal conviction; indeed, the rule comes nearly to this, that one must have contemporaneous records, verbal or structural. Furthermore it is apparent that to introduce such records does not prove the date of their origin, except grossly, as they bear internal evidence of antiquity, or precisely, if they carry their own date upon them. When the issue concerns so short a time as that at bar, the appearance of the exhibit helps not a jot to fix the date of its production, and upon the relevant issue we are as much dependent upon oral testimony as though it had never been introduced at all. Thus we cannot regard Exhibit W as adding any more to the proofs than Exhibit V; it tells us that it was made, but not just when. That is all that is important here. Decree affirmed.”*

“It appears that the prior use of this wire was set up in a case, by these same plaintiffs against one Haish, in the Circuit Court for the Northern District of Illinois, 10 Brissel 65, and was held to have been insufficiently proved. *A specimen of the twisted wire produced in that suit was also put in evidence in this.* It is very improbable that it could have been invented by a boy in his early teens, such as Beers was then. The testimony also indicates that the exhibit is constructed of a variety of steel which did not come into use until after 1870. Upon the whole, the evidence fails to satisfy us that this fence was constructed before application was made for the Glidden patent.”

The Washburn and Moen Mfg. Co., *et al.*, v. The Beat 'Em All Barbed Wire Co., *et al.*, *supra*.

“In view of the fact that the validity of the Peeler patent has been sustained by the Circuit Court of Appeals for this circuit, and the decisions above cited

declaring the rule of evidence concerning the showing a litigant must make, one should be very reluctant to declare this patent invalid on a *single reference* of the kind here presented, where there is no corroborative proof or *documentary evidence* to substantiate a claim that a buckle such as *Exhibit 21* was actually made and marketed under a patent issued many years before the application for the patent in suit was filed. To invalidate a patent under such circumstances as are here presented would open the door to an evil which could not be tolerated.”

Waterbury Buckle Co. v. V. G. E. Prentice Mfg. Co., 294 F. 935.

“There is no reason, however, to regard it (the “B. M.” binder) as an experiment. \* \* \* It is probable that this modification the defendant actually perfected in the summer of 1914 and one of the issues in the case turns upon whether the proof is adequate for that purpose. Nevertheless, although I have really no doubt that this was in fact done, I think the proof scarcely comes up to the *severe* standard imposed in such cases. There is *no documentary corroboration* of it, and the testimony of the witnesses, though unimpeached, is not supported by any circumstances *which put it beyond the inevitable infirmities of their recollection*. The most recent declaration of the Supreme Court in *Symington v. Nat. Castings Co.*, 250 U. S. 383, 39 Sup. Ct. 542, 63 L. Ed. 1045, shows no disposition to relax the well-established cannon, and I decline to consider the *use* as proved.” *Kalamazoo Loose Leaf Binder Co. v. Wilson Jones L. L. Co.*, 286 Fed. 717.

*National Brake Beam Co. v. Interchangeable Brake Beam Co.*, *supra*.

The following cases are in point :

“As to the suggestion that there should have been produced a photograph or description by a competent witness of *doors still in use*, we fail to see what bearing that would have on the question. No one disputes that the doors are the same, nor that they are *now*

equipped with the "stop" devices. The only question is *when* those devices were applied. *Peelle Co. v. Rashkin*, 222 Fed. Rep. 296 (the court holding the evidence insufficient to prove prior use and holding the patent infringed).

"IT IS WELL SETTLED THAT THE ORAL TESTIMONY OF MANY WITNESSES, IF UNSUPPORTED BY ANY EVIDENCE CONSISTING OF DOCUMENTS OR THINGS, MUST BE VERY REASONABLE OR VERY STRONG TO ESTABLISH THE DEFENSE OF PRIOR USE."

*Carson v. American Smelting and Refining Co.*, 11 F (2nd) 771 (citing *Kalamazoo Loose Leaf Binder Co. v. Wilson Jones L. L. Co.* and the *Barb Wire Case Supra.*)

In the Case at Bar There Are Not Many Witnesses Nor Is the Testimony as to Prior Use Very Reasonable or Very Strong, But on the Contrary the Defendant-Appellee Has Produced Only a Very Few Witnesses Who Gave Only Oral Testimony, Unsupported by Sufficient Documents or Their Equivalents, Which Is Very Unreasonable and Very Weak, and It Is Submitted That the Defendant-Appellee Has Failed to Establish His Defense of Prior Use in Accordance With the Rule of Evidence Laid Down by This Court in *Carson v. American Smelting and Refining Co.*, *Supra*, and by the Leading Authorities Before Cited.

Upon reviewing the defendant-appellee's evidence of alleged prior *public* use, the court will note that *not a single witness*, besides Emil R. Bossard and his wife, except the defendant, Atherton, an interested and discredited witness, *was produced* to testify that he saw the defendant-appel-

lee's alleged "louver" in Bossard's house more than two years prior to the date of the application for the patent in suit.

Chief Justice Taney in *Gayler v. Wilder*, 10 How. 497, 13 L. Ed. 512, said:

"By knowledge and use the Legislature meant knowledge and use \* \* \* *accessible to the public.*"

Was the alleged use of the defendant's louver in Bossard's private residence "accessible to the public?"

We submit, that to hold that the uncorroborated testimony of one man and his wife, as to an alleged prior public use, of a valuable invention, in their private residence is sufficient to invalidate United States Letters Patent, would set a dangerous precedent, which would open wide the door to perjury and fraud. The validity of any patent might be successfully attacked by evidence of such character.

"THE SOLEMN GRANTS OF GREAT FRANCHISES CANNOT BE STRICKEN DOWN BY TESTIMONY SO FLIMSY AND UNSATISFACTORY."

*National Brake Beam Co. v. Interchangeable Brake Beam Co., Supra.*

A fact of no mean magnitude, which we feel should not be overlooked, is the phenomenal commercial success of the plaintiff-appellant's register. Under the supposed protection of the patent in suit the plaintiff-appellant, by frugal industry, has, in good faith, built up a business of manufacturing and selling its patented register amounting approximately to about \$200,000 a year, or grossly to about a million dollars since 1924, when the plaintiff-appellant

started manufacturing its register. [Tr. pp. 32-33.] The plaintiff-appellant's register is obviously a meritorious invention—at least the defendant-appellee “pays it the flattery of imitation.”

Counsel for defendant-appellee contends that the plaintiff-appellant has built up no business at all, under the patent in suit, inasmuch as plaintiff's register, Exhibit 6, has the shutter *pivot* rods made in two pieces (or rivets, Tr. p. 35) instead of one, but we submit that such a contention is obviously nothing more than mere quibbling, in the face of the authorities which we have cited, in considering Issue 2, to the effect that an element made in two pieces is the mechanical equivalent of a like element made in one piece and that such equivalents are within the scope of the patent in suit.

To declare invalid United States Letters Patent, such as the patent in suit, is, to say the least, a very grave matter, and we submit that the rule as laid down in *Block v. Nathan Anklet Support Co. supra*, that “THE PROOF MUST BE AS ABSOLUTE AS IN A CRIMINAL CONVICTION,” to overthrow the strong presumption of validity of United States Letters Patent, should be applied with full force and effect in the case at bar and particularly in view of the ruling laid down in the case of *Douglas Pectin Corp. v. Armour Co.*, 27 F. (2nd) 814, as follows:

“A very high degree of proof is required to establish anticipation of a patent by prior use.

“MERE RECOLLECTION OF REMOTE EVENTS SHOULD NOT BE ALLOWED TO OVERTHROW A PATENT, FOLLOWED BY GREAT COMMERCIAL SUCCESS.”

The same ruling was laid down by this court in the case of Diamond Patent Co. v. S. E. Carr Co., 217 Fed. 402 as follows:

“Under the rule established by these decisions, we are required to view with caution and careful scrutiny evidence which is introduced to show prior use that destroys the pecuniary value of a patent, which has met with *commercial success* and has been of *value to the community.*”

We feel that the meritorious conduct of the plaintiff-appellant should, in the final analysis, appeal strongly to the high sense of justice of this Honorable Court, because it was the plaintiff-appellant and the patentee (Carter) of the patent in suit who, in the language of the United States Supreme Court, in the aforesaid Barbed Wire Case.

“FIRST PUBLISHED THIS DEVICE; PUT IT UPON RECORD; MADE USE OF IT FOR PRACTICAL PURPOSE; AND GAVE IT TO THE PUBLIC, BY WHICH IT WAS EAGERLY SEIZED UPON.” \* \* \*

the court concluding as follows:

“UNDER THESE CIRCUMSTANCES WE THINK THE DOUBTS WE ENTERTAINED CONCERNING THE ACTUAL INVENTOR OF THIS DEVICE SHOULD BE RESOLVED IN FAVOR OF THE PATENTEE.”

## SUMMARY.

The defendant-appellee is estopped from denying the validity of the patent in suit by his admission in his bill of particulars of the novelty of the essential features of construction of the register covered by the patent.

The construction of the defendant-appellee's "louver" and particularly Exhibit 7, falls within the terms of the patent in suit and the defendant-appellee infringes the patent in suit.

The defendant-appellee has failed to prove his defense of prior public use according to the rule of evidence laid down by the Supreme Court of the United States in the Barbed Wire Case and by this court in Carson v. American Smelting and Refining Co. *supra*.

## Conclusion.

We submit that the patent in suit is valid and is infringed by the defendant-appellee, and that the decree of the lower court should be reversed in favor of the plaintiff-appellant as prayed in the bill of complaint herein.

Respectfully submitted.

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*Attorney for Appellant.*

